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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,281	12/03/2003	Edward Dewey Smith III	7682MC2	6919

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT PAPER NUMBER

1771

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,281

Applicant(s)

SMITH ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 26,32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,27-31,33 and 35-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/04,3/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 25, 27 – 31, 33, and 35 – 58, drawn to personal care article, classified in class 442, subclass 59.
 - II. Claims 26, 32, and 34, drawn to a method of using a personal care article, classified in class 134, subclass 42.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used to clean other surfaces such as counters, desks or cars, instead of cleaning skin and hair.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Cindy Clay on June 1, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 – 25, 27 – 31, 33, and 35

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– 58. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 26, 32, and 34 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1 – 25, 27 – 31, 33, 35, and 36 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 – 25, 27 – 31, 33, 35, and 36 of copending Application No. 10/677,868. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 25, 27, 33, and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,153,208. Although the conflicting claims are not identical, they are not patentably distinct from each other because both articles comprise a water insoluble, two layer laminate, a lathering surfactant, and a conditioning component. The substrates as claimed by US 6,153,208 and Applicant are not distinct since the substrate is claimed by properties which do not limit or exclude either substrate from being made of the same two layers as the other substrate.

11. Claims 1 – 5, 9 – 13, 16 – 18, 21 – 25, 27 – 31, 33, 35 – 37, 39 – 48, and 54 – 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 7, 9, 10, 12, 14, and 16 – 19 of U.S. Patent No. 6,267,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to a two layer water insoluble substrate, comprising a cleansing component, a therapeutic component, or both. The substrates are claimed based on different properties that do not exclude the water soluble substrate claimed in 6,267,975 from also having the properties claimed in Applicant's application.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 5 – 8, 11, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “batting layer composite material” in claim 5 is used by the claim to mean a material formed from various substrates including foam layers, polymeric nets, and films, while the accepted meaning is “a soft, bulky assembly of fibers.” The term is indefinite because the specification does not clearly redefine the term and the batting material should at least have a group of fibers loosely entangled or bonded together. Claim 7 is similarly rejected. Claims 6 and 8 are rejected due to their dependency on claim 5 and 7. For purposes of examination, the composite batting layer requires any type of nonwoven layer with some degree of loftiness. Also, a composite material can be made from multiple types of materials and not require multiple layers.

Therefore, any single layer nonwoven material made from more than one type of fiber will read on the claimed composite batting layer.

15. Claims 11 and 43 are rejected since the applicant recites that the nonwoven material can be made from films, foams, sponges and scrims. By definition a nonwoven material is a fibrous material produced by chemically, thermally, or mechanically bonding fibers together by means

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other than weaving or knitting. Materials including films and foams do not by definition qualify as nonwoven materials. Thus, the use of the term nonwovens is repugnant to its recognized definition.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1, 2, 5 – 25, 27 – 31, 33, 37 – 40, and 43 – 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haq (4,515,703) in view of Hasenoehrl et al. (WO 99/21532 A).

Haq discloses a wiping material suitable for cleaning surfaces such as household surfaces and human skin (column 1, lines 4 – 6). The wipe comprises a substrate material having a first and second layer bonded together to create a plurality of compartments there between, at least some of the compartments containing an active material and perforations to release the active materials through (column 1, lines 55 – 62). The active material can be soap and detergent compositions, disinfectant, bubble bath, and skin treatment agents, or combinations of these (column 1, line 65 – column 2, line 4). The substrate layers are made from porous or water-permeable material such as nonwoven fabrics so that water can pass through the wipe and the active solution may exit the wipe (column 2, lines 45 – 55). The nonwoven material can be made from various fibers including cotton, viscose, and polyamides (column 8, lines 8 – 10). Preferably the substrate layers are made from perforate film layers which control the release rate of the active solution and soft outer surfaces which is absorbent and has improved handling

(column 3, lines 10 – 20). Haq discloses that the preferred material is a substrate having a plastic film layer bonded to a nonwoven fabric layer (column 3, lines 21 – 28). The substrate layers are thermally bonded together in a grid pattern to create the compartments (column 3, line 60 – column 4, line 8). The substrates are perforated so that the active material can be released at a controlled rate (column 4, lines 37 – 43). Preferably the perforations have a size in the range of 0.2 to 1.2 mm (column 4, lines 50 – 55). Haq also discloses that the different sides of the wipe can have different textures by adding an abrasive material to one side of the wipe to improve cleaning efficiency (column 5, lines 6 – 35). However, Haq fails to teach that amount of active solution added to the wipe.

Hasenoehrl et al. is drawn to a multi-layered wipe substrate containing a cleansing composition. Hasenoehrl et al. discloses that the cleansing composition applied to the substrate includes 0.5 to 12.5%, by the weight of the substrate, a lathering agent (page 20, lines 12 – 16). The lathering agent includes anionic, nonionic, and amphoteric lathering surfactants (page 20, lines 22 – 25). The coating can also include 0.05% to 99%, by weight of the substrate, a conditioning component (page 41, lines 13 – 17). The conditioning agent would serve as a therapeutic benefit agent by keeping the skin moist, thus acting as a skin treating agent. Hasenoehrl et al. also discloses that the conditioning agent can be added as an emulsion, including a water-in-oil emulsion and a coacervate-forming composition (page 47, second paragraph). Additionally, Hasenoehrl et al. disclose that the coating can include other therapeutic benefit agents such as anti-acne actives, anti-wrinkle and anti-skin atrophy actives, topical anesthetics, artificial tanning agents and accelerators, anti-microbial and anti-fungal actives, and sunscreen actives (page 63 – 65). Therefore, it would have been obvious to one of

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ordinary skill in the art to add various components including lathering surfactants and therapeutic benefit as disclosed by Hasenoehrl et al. agents to the wipe taught by Haq in an amount ranging from 0.5% to 99% as disclosed by Hasenoehrl et al. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose to add from about 10% to about 1000% of the cleansing composition, by weight of the substrate, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). One of ordinary skill in the art would be motivated to add enough cleanser so that the wipe would be able to clean a large surface area before the cleaner runs out so that the user will be able to get a long life from the cleansing wipe before throwing the wipe away. Therefore, claims 1, 5 – 8, 11 – 19, 21 – 25, 27 – 31, 33, 38, 39, 43, 44, 47 – 52, and 54 – 58.

Haq fails to teach the specific diameter of the fibers in the batting layer, density and thickness of the batting layer, and the thickness of the film layers. However, it would have been obvious to one having ordinary skill in the art to choose the diameter of the fibers, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill in the art would be motivated to choose a fiber diameter which would provide the nonwoven fabric with a soft feel and good cleaning ability without using fibers that are too large that they become stiff, inflexible, and harsh during use. Thus, claims 2 and 40 are rejected.

One of ordinary skill in the art would also be motivated to choose the claimed thickness and the density of the batting layer, as well as the thickness of the additional film layer to produce a wipe structure that is soft and lightweight as well as flexible. Further, one of ordinary skill in the art would want to optimize these properties so that the wipe can absorb a sufficient amount of liquid during the cleaning process as well as efficiently clean the surface. Therefore, claims 9, 10, 20, 45, 46, and 53 are rejected.

With respect to the abrasiveness value recited in claim 37, Haq discloses that various particles of materials can be added to the composite to produce a different levels of abrasiveness. Although the limitations of abrasiveness value are not explicitly taught by Haq or Hasenoehrl et al., it is reasonable to presume that said limitations would be met by the combination of the two references. Support for said presumption is found in the use of similar materials (i.e. nonwoven fabric and abrasive particles) used to produce the wipe with various abrasive levels. The burden is upon the Applicant to prove otherwise. Thus, claim 37 is rejected.

18. Claims 3, 4, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haq and Hasenoehrl et al. as applied to claims 1 and 25 above, and in further view of Horn (5,302,446).

The features of Haq and Hasenoehrl et al. have been set forth above. Although, Haq teaches that the nonwoven material can be made from synthetic materials, Haq fails to teach using a multi-component fiber in the batting layers. Haq discloses that the nonwoven layers should contain a portion of thermally bondable fibers so the wipe can be heat-sealed (column 3, lines 54 – 59). Horn discloses it is known to make multi-layered skin care wipes with bi-component materials (column 1, lines 32 – 40). The bi-component fibers can be melted upon

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heating and bond with the other fibers adjacent to the bi-component fibers (column 1, lines 41 – 46). Thus, it would have been obvious to one having ordinary skill in the art to substitute bi-component fibers in for the fibers in the batting layer to provide the batting layer with extra strength and structural integrity by thermally bonding the fibers together. Therefore, claims 3, 4, 41, and 42 are rejected.

19. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haq and Hasenoehrl et al. as applied to claims 1 and 27 above, and in further view of Martin et al. (5,702,992).

The features of Haq and Hasenoehrl et al. have been set forth above. Haq fails to teach packaging the personal care articles with other substrates. Martin et al. is drawn to disposable cloths impregnated with cleansing solutions. Martin et al. teach to package the cloths in small groups to be used as individual cleaning systems (column 6, lines 32 – 55). Thus, it would be obvious to one having ordinary skill in the art to package the cleansing articles taught by Haq in a personal care kit so that the cleansing articles can be employed in hospitals and locations away from running water to quickly clean a persons hands and face or entire body. Also, packaging the cleansing articles would prevent the articles from drying out or being ruined before they are used. And packaging the articles in groups of more than one cleansing sheet would be more efficient and require less packaging materials, saving money.

Finally, any package comprising one or more cleansing articles taught by Haq. would inherently comprise a substrate with a therapeutic agent and another substrate, since the other cleansing articles, as well as the package itself, are substrates. Also, a package with more than one cleansing article would comprise a substrate with a lathering surfactant and a substrate with

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a therapeutic benefit agent since Haq disclose substrates can have both components. Therefore, claims 35 and 36 are rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo
October 18, 2004



CHERYL A. JUSKA
PRIMARY EXAMINER